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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,930	01/30/2004	Jerome R. Mahoney	IVC-114A	7793

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EXAMINER

WIN, AUNG T

ART UNIT PAPER NUMBER

2617

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/768,930	Applicant(s) MAHONEY, JEROME R.	
	Examiner Aung T. Win	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/30/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 6 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "sufficient" in claim claims 6 and 12 are a relative term, which renders the claim indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rapchak (US Patent Number: US007002476B2) in view of Shizuka et al. (US Publication Number: US 20030014252A1), further in view of Mariano et al. (US Publication Number: US 20030156724A1).

- 2.1 Regarding Claims 1 and 4, Rapchak discloses a method of communicating prescription medicine instructions to a patient. Rapchak's method provides a user with small dispensing medication unit 16 (claimed medicine container) including a removable

dispenser 12 (claimed storage area) that contains medications for the user under control of information downloaded through attached wireless transceiver. Rapchak's downloaded information comprises a set of audio instructions WAV files that instruct the user on how to use the dispensed medication [Summary] [Figures 1 & 2; Column 2, Line 64- Column 5]. Thus, Rapchak's method teaches claimed providing steps. At the time of invention of made, it is obvious to one of ordinary skill in the art that Rapchak's dispensing medication unit includes corresponding claimed means in order to reproduce downloaded WAV file to the user.

Rapchak also discloses a host 20 (claimed central processor) to transmit audio instruction wave file or text instruction word files wirelessly. Rapchak fails to disclose creating a wav files steps i.e., creating wav file from user input text instruction although Rapchak discloses a text instruction word file.

At the time of invention of made, text-to-wave converting means are very well known to one of ordinary skill in the art. Moreover, Shizuka discloses the method of converting speech data corresponding to user input text using personal computer [Paragraph 0026-0028] [Figure 3, 4 & 5].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to modify wav file creating method of Rapchak's system from user input utilizing text-to-speech conversion mechanism installed computer as taught by Shizuka for pharmacist to provide additional medication instructions in response to patient inquiry and concerns in a wave file.

Mariano discloses pill container and activating member for activating a sound player for providing audio instructions to a user of medication especially for visually impaired user [Paragraph 0027-0031].

Mariano discloses a recorder to record audio instructions either from recorder's MIC or a computer running computer speech software [Paragraph 0036 & 0037] via interface port 70 or wirelessly such as infrared or short-range radio transceiver [Paragraph 0038].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention of made to modify Rapchak's method as claimed by Shizuka and Mariano's method in order to provide prescription instruction to visually impaired user.

2.2 Claims 7 and 10 are rejected for the same reason as stated above in Claim 1 rejection because claimed methods substantially read on the corresponding method of Claim1.

2.3 Claim 13, 16, 18 and 21 are rejected for the same reason as stated above in Claim 1 rejection because it is obvious to one of ordinary skill in the art at the time of invention of made that modified claimed method teaches corresponding claimed means in order to implement modified claimed method.

2.4 Regarding Claim 2, 8, 14 & 19, modified method teaches a computer system with claimed input means [Shizuka: Figures 2-5].

2.5 Regarding Claims 3, 9, 15 and 20, modified method teaches claimed steps because modified method discloses claimed unique identifier i.e., drug identifier contained in downloaded medication files [Rapchak: Column 4, Line 28] so that the instructions corresponding to each drug identifier and right medication can be provided to the user. Therefore, modified method teaches claimed steps.

2.6 Regarding Claims 5, 11, 17, & 22, modified method teaches converting speech to wave file [Mariano; Figure 4] for creating instructions.

2.7 Regarding Claims 6 & 12, modified method teaches providing different medications to the user identified with different drug identifier as stated in Claim 3 rejection. Moreover, claimed selecting step is very well known to one of ordinary skill in the pharmaceutical art at the time of invention of made because claimed preset data collection of prescription medicine instructions corresponding to a specific medication and dosage combination are stored in the processing computer memory or database for pharmacist to prepare medication instructions. Therefore, it is obvious to one of ordinary skill in the art that modified method teaches claimed selecting step because modified method teaches creating medication instructions steps.

Conclusion

Art Unit: 2617

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dobbins US Patent Number: US 006259794B1

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aung T. Win whose telephone number is (571) 272-7549. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aung T. Win
Group Art Unit 2617
May 8, 2006


DUC NGUYEN
PRIMARY EXAMINER

~~DUC NGUYEN
PRIMARY EXAMINER~~